

REMARKS/ARGUMENTS

This Amendment and Response is fully responsive to the final Office Action dated July 13, 2010.

Claims 1-13, 16 and 18-23 are pending. Claims 1-8, 10, 11 and 16 are herewith cancelled. Claims 9, 12, 22 and 23 are currently amended. These amendments are supported throughout the specification and figures; in particular, see at least paragraphs [0028] and [0029] of the specification.

Any amendments presented herein are made solely to expedite prosecution of the application without admission as to the propriety of the rejections set forth in the present Office Action and without acquiescence to Examiner's characterization of the claims or prior art. Applicants respectfully reserve the right to include claims of the same or different scope as previously written in one or more continuing applications.

Claim Rejections – 35 U.S.C. § 112, first paragraph

Claims 9, 10-13 and 18-23 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Claims 9, 22 and 23 are currently amended. Accordingly, reconsideration and withdrawal of the 35 U.S.C. § 112, first paragraph, rejection of these claims are respectfully requested.

Claim Rejections – 35 U.S.C. § 112, second paragraph

Claims 10, 22 and 23 stand rejected under 35 U.S.C. § 112, second paragraph, as indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 10 is herewith cancelled and claims 22 and 23 are currently amended. Accordingly, reconsideration and withdrawal of the 35 U.S.C. § 112, second paragraph, rejection of these claims are respectfully requested.

Claim Rejections – 35 U.S.C. § 103

Claims 9-13 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Grad *et al.* "Chondrocyte SZP/lubricin Expression Is Mediated by Applied Surface Motion"; Tissue Eng., 200 Sept; 9(4): 797-8 ("Grad"), U.S. Pat. No. 5,702,456 ("the '456 patent") and U.S. Pat. No. 5,891,558 ("the '558 patent").

In making the assessment of differences between the prior art and the claimed subject matter, section 103 specifically requires consideration of the claimed invention "as a whole."

See M.P.E.P. § 2141.02 (“[T]he question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious.”).

Amended independent claim 9, which now includes the limitations of claims 10 and 11, recites, with emphasis:

A method for the production of a natural cartilage replacement material, wherein said natural cartilage replacement material comprises an open-pored, elastic cell-carrier body populated in its pores with chondrocytes, comprising:
dissolving in a physiologically acceptable solvent a mixture of lubricin and hyaluronic acid to form a solution,
bringing said solution in contact with the chondrocytes by moving said solution over the cell-carrier body with a laminar flow.

Applicants respectfully submit that neither Grad, the ‘456 patent nor the ‘558 patent disclose all of the elements of independent claim 9. For example, the cited references do not disclose, teach or suggest the above-emphasized language as claimed.

In rejecting claim 11, which stated “wherein said solvent is moved over the cell-carrier body with a laminar flow,” the Examiner alleged that

the ‘558 patent teaches a solution containing hyaluronic acid brought in contact with a cartilage replacing implant by sliding across one another. It would be prima facie obvious to one of ordinary skill in the art at the time the invention was made to use the sliding force taught by the ‘558 patent to bring cartilage implant taught by Grad and the solution taught by the ‘456 [patent] in contact because the ‘58 patent teaches a rotation and sliding to contact the hyaluronic acid containing solution and Grad teaches surface motion and rotation being applied to the cartilage construct.

Office Action, page 11.

Neither the ‘558 patent, the ‘456 patent nor Grad discloses the claim language highlighted above. For at least the foregoing reason, independent claim 9, is believed to be allowable over the cited. Claims 12, 13 and 18-23 depend from claim 9 and are therefore allowable for the reasons that claim 9 is believed to be allowable.

CONCLUSION

In view of the foregoing remarks, Applicant respectfully submits that the present application is in condition for allowance and such action is respectfully request. Should the Examiner feel that there are any issues outstanding after consideration of the response, the Examiner is invited to contact Applicants' undersigned representative to expedite prosecution.

EXCEPT for issue fees payable under 37 C.F.R. § 1.18, the Director is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. §§ 1.16 and 1.17 which may be required, including any required extension of time fees, or credit any overpayment to Deposit Account No. 50-0310 (Matter No. 060960-5060). This paragraph is intended to be a CONSTRUCTIVE PETITION FOR EXTENSION OF TIME in accordance with 37 C.F.R. § 1.136(a)(3).

Respectfully submitted,
Markus Wimmer et al.

Dated: 12/7/2010

/Squire J. Servance/
Squire J. Servance
Registration No. 65,135
Kenneth J. Davis
Registration No. 50,688

MORGAN, LEWIS & BOCKIUS LLP
1701 Market Street
Philadelphia, PA 19103-2921
Telephone: (215) 963-5000
Direct Dial: (215) 963-5392
Facsimile: (215) 963-5001